

REMARKS

The present response amends claims 1, 9, and 18. Claims 1-20 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Allowable Subject Matter

Claims 12, 13, 16, and 18 were deemed allowable if placed into independent form, including any intervening claims. As set forth in the Office Action, the prior art does not anticipate or fairly suggest, *inter alia*, the memory module being interchangeable with a memory card and surrounded by a covering that employs a mechanical tab (claim 18), nor does the prior art anticipate or fairly suggest an outer edge of the memory module having ends of a plurality of conductors adapted for slideable engagement into a receptor that is electrically connected to an electronic system (claims 12 and 13).

Applicants agree with the assessment given in the Office Action and appreciate the Examiner's indication of allowable subject matter contained in the allowable claims. For reasons set forth below, the present independent claims 1 and 9 are hereby amended to include specific derivations of the allowable subject matter.

Section 103 Rejection

Claims 1-7, 8-11, 14, 15, 17, and 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,583,512 to Nakaoka et al. (hereinafter "Nakaoka") in view of U.S. Patent No. 6,515,359 to Corisis et al. (hereinafter "Corisis") and further in view of U.S. Patent No. 6,531,773 to Nishizawa et al. (hereinafter "Nishizawa"). To establish a case of *prima facie* obviousness of a claimed invention, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Finally, the prior art references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP 2143.03 (emphasis added). Specifically, "all words in a claim must be considered when judging the patentability of that claim

against the prior art.” *In re Wilson*, 424 F.2d. 1382 (CCPA 1970). Using these standards, Applicants contend that the cited art fails to teach or suggest all features of the currently pending claims, some distinctive features of which are set forth in more detail below.

The combination of Nakaoka, Corisis, and/or Nishizawa does not teach or suggest a memory module that is interchangeable with a memory card (claim 9), or which has conductors with ends that can slideably engage into a receptor (claim 1). Present independent claims 1 and 9 each define a memory module. The memory module of claim 1 specifically recites a plurality of conductors having a second end which terminates in a row near an edge of the memory module. Moreover, the second end of each of the plurality of conductors is adapted for slideable engagement into a receptor. Claim 9, on the other hand, defines the memory module as being interchangeable with a memory card. A memory card, like all cards, is known to be that which can “plug into a bus backplane.” See IEEE Std. 100-1992, The New IEEE Standard Dictionary of Electrical and Electronic Terms, 5th Ed., pg. 159.

Applicants agree with the assessment given on page 4 of the Office Action, stating that the prior art does not teach a memory module adapted for slideable engagement into a receptor. Nakaoka, Corisis, and Nishizawa clearly disclose a package for integrated circuits with leads extending from a lateral surface of that package. The leads within each of those references are ones which, by design, cannot be inserted into a receptor. For example, Corisis and Nishizawa show leads that are designed for solder reflow bonding to a printed circuit board or card (Corisis -- leads 104 in Figs. 1 and 2; Nishizawa -- leads 7B in Figs. 3-5). Any attempts to insert the outward extending leads in Corisis or Nishizawa into a receptor would cause the leads to deleteriously bend and, therefore, skew from their intended receptor target area. This is especially so whenever the leads are of fine pitch and are numerous as in the case of the packages taught in Corisis and Nishizawa.

The only reference which shows flush-mounted (or leadless) packages is described in Nakaoka. However, leads 32 in Nakaoka are specifically described, and shown, as being on opposing sides of package 35 (Nakaoka -- Figs. 1-4). By configuring leads on all four sides of the package, Corisis cannot accommodate insertion of a row of leads, as claimed, into a receptor and yet maintain functionality and interchangeability with a memory card, as also claimed. For example, if one edge of Corisis comprising a row of leads is inserted into a receptor or bus backplane, then the leads on the opposing edge would be connected to nothing. This would render the packaged integrated circuit of Corisis inoperable for its intended functional purpose.

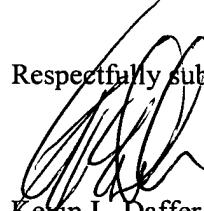
For at least the reasons stated above, Applicants assert that independent claims 1 and 9, as well as claims dependent therefrom, are patentable over the cited art. Accordingly, Applicants respectfully request removal of this rejection.

CONCLUSION

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed July 1, 2003. In view of the remarks traversing the rejections, Applicants assert that pending claims 1-20 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5732-00300.

Respectfully submitted,



Kevin L. Daffer
Reg. No. 34,146
Attorney for Applicant(s)

Conley Rose, P.C.
P.O. Box 684908
Austin, TX 78768-4908
(512) 476-1400
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